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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* SHELL S. SIMPSON, WARD S. FOSTER,
9 and KRIS R. LIVINGSTON
10

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12 Appeal 2007-1496
13 Application 09/874,427¹
14 Technology Center 2100
15

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17 Decided: December 13, 2007
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21 Before ALLEN R. MACDONALD, JEAN R. HOMERE, and
22 CAROLYN D. THOMAS, *Administrative Patent Judges*.
23

24 THOMAS, C., *Administrative Patent Judge*.
25

26 DECISION ON APPEAL
27

3¹ Application filed June 4, 2001. The real party in interest is Hewlett-
4 Packard Development Company, LP.

1 I. STATEMENT OF THE CASE

2 Appellants appeal under 35 U.S.C. § 134 from a Final Rejection
3of claims 1-8, 11, and 14-37 entered September 20, 2005. We have
4jurisdiction under 35 U.S.C. § 6(b).

5 We affirm.

6
7 A. INVENTION

8 Appellants invented a system, method, and computer useable medium
9for representing production devices on a computer network by hosting an
10interface for one or more production devices. (Specification 2.)

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12 B. ILLUSTRATIVE CLAIMS

13 The appeal contains claims 1-8, 11, and 14-37. Claims 1, 7, 8, 16, 22,
1428, 29, and 35 are independent claims. As best representative of the
15disclosed and claimed invention, claims 1, 28, and 29 are reproduced below:

16 1. A method for representing production devices on a network, the
17method comprising:

18 hosting an interface for one or more production devices, each
19interface having user accessible controls for selecting production options for
20a target document;

21 providing the interface for a selected one of the production
22devices to a client upon receipt from the client of a production request for
23the target document; and

24 managing the production of the target document for the selected
25production device using production options selected through the interface.

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1 28. A system for representing production devices on a network,
2comprising:

3 a database containing production logic for one or more
4production devices, the production logic for each production device
5including data for generating a user interface having particular controls for
6selecting production options:

7 a device locator operable to detect and identify new devices
8present on the network;

9 an update service operable to acquire the production logic for
10each of the detected devices and update the database with the acquired
11production logic;

12 an interface generator operable to access the production logic
13for a production device in the database and serves an interface for the
14production device, the interface being generated to include user accessible
15controls for selecting production options for a document as specified by the
16production logic for that production device;

17 a plan generator operable to merge the document with the
18production options selected through the interface; and

19 a device driver operable to deliver the production plan to the
20production device.

21

22 29. In a computer network, a system for managing electronic
23document production over a computer network, the system comprising:

24 one or more production devices;

25 a client operable to identify a target document, select one of the
26one or more production devices, and direct a production request to the
27selected production device;

28 a proxy service in electronic communication with the client and
29the production device, the proxy service operable to return, in response to
30receiving a production request, to the client an interface for selecting
31production options for the selected production device and to manage the

1production of the target document for the selected production device using
2production options selected through the interface.

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4 C. REFERENCES

5 The references relied upon by the Examiner in rejecting the claims on
6appeal are as follows:

7	Levine	US 5,974,234	Oct. 26, 1999
8	Goodman	US 6,757,071 B1	Jun. 29, 2004

9
10 D. REJECTIONS

11 The Examiner entered a Final Rejection on September 20, 2005 with
12the following rejections which are before us for review:

13 1. Claims 1-8, 11, 15-22, 24-27, 29-34, and 36-37 are rejected under
1435 U.S.C. § 102(b) as being anticipated by Levine; and

15 2. Claims 14, 23, 28, and 35 are rejected under 35 U.S.C. § 103(a) as
16being unpatentable over Levine in view of Goodman.

17
18 II. PROSECUTION HISTORY

19 Appellants appealed from the Final Rejection and filed an Appeal
20Brief (Br.) on June 7, 2006. The Examiner mailed an Examiner's Answer
21(Answer) on August 2, 2006. Appellants filed a Reply Brief (Reply Br.) on
22September 28, 2006.

23 III. ISSUE(S)

24 The issue is whether Appellants have shown that the Examiner erred
25in rejecting the representative claims. The issue specifically turns on

1whether Levine discloses providing an interface for production devices that
2includes user accessible controls.

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IV. FINDINGS OF FACT

7 The following findings of fact (FF) are supported by a preponderance
8of the evidence.

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Levine

10 1. Levine discloses “[a] printing system in which one or more clients
11communicate with a plurality of printers by way of a print server whose
12architecture is characterized by a plurality of layers, . . . one of the plurality
13of layers receives a request from one of the one or more clients and the
14request designates an operation to be performed with respect to one of the
15plurality of printers.” (Abstract.)

16 2. Levine discloses that “[i]nformation transferred and displayed to
17the client includes both static information defined in advance and dynamic
18information computed at the time that a client makes a request to the server.”
19(Col. 4, ll. 12-15.)

20 3. Levine discloses that “the client requests a URL (web page) for a
21particular device of a particular type (1).” (Col. 13, ll. 9-10.)

22 4. In Levine, “[t]he application layer retrieves the appropriate web
23page, plugs in the data and returns the page to the client (11,12).” (Col. 13,
24ll. 17-19.)

1 5. Levine discloses that “[f]or Altered Site Settable Values and Job
2Management Command: In each case, the client sends the data and its
3purpose to the HTTP server (1).” (Col. 13, ll. 26-29.)

4 6. In Levine, “Job Management Commands enable a user to issue
5commands to jobs the interface knows about in the Window NT queue or on
6the destination device’s hard disk if any.” (Col. 15, ll. 63-65.)

7 7. Levine discloses a “DM subsystem [that] validates user requests,
8queues requests, spools document data, schedules the job for the device, and
9collects and maintains status information.” (Col. 8, ll. 61-63.)

10 8. In Levine, if there is a request to have a device added, “a check is
11performed . . . , an Add function call is, at step **224**, filled out with the name
12of the device to be added.” (Col. 15, ll. 17-24.)

13 9. Levine discloses that “the device data cache & device/user
14database **204** . . . stores all relevant information that the proxy server has
15acquired from the devices **200**. The stored information includes, among
16other things: a list of the devices **200**, . . . the driver(s) for each device,
17references to appropriate strings and bitmaps to be displayed at the client for
18each device.” (Col. 10, ll. 45-57.)

19 10. Levine discloses that “in a typical proxy server an application
20layer communications with a connectivity layer which permits the operation
21requests to be transferred between the clients and the document processing
22devices. Some client/server based software accommodates for the
23connectivity layer through an interface referred to as Middleware.” (Col. 4,
24ll. 58-63.)

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V. PRINCIPLES OF LAW

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“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 6628, 631 (Fed. Cir. 1987). Analysis of whether a claim is patentable over the prior art under 35 U.S.C. § 102 begins with a determination of the scope of the claim. We determine the scope of the claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). The properly interpreted claim must then be compared with the prior art.

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“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S. Ct. at 1734 (“While the sequence of these

1 questions might be reordered in any particular case, the [*Graham*] factors
2 continue to define the inquiry that controls.”)

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VI. ANALYSIS

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Pending Claims 1-8, 11, and 14-37 *Grouping of Claims*

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8 (1) In the Brief, Appellants argue claims 1-6, 16-21, and 36-37 as a
9 group. In other words, for claims 2-7, 16-21, and 36-37, Appellants merely
10 repeat the same argument made for claim 1. Thus, the Board selects
11 representative claim 1 to decide the appeal for this group. 37 C.F.R.
12 § 41.37(c)(1)(vii)(2006). Accordingly, the remaining claims in this group
13 stand or fall with claim 1.

14 Appellants separately argue claims 7, 8, 22, 28, and 29.

15 (2) Claim 7 will be addressed separately.

16 (3) Appellants argue claims 8, 11, 14, and 15 as a group. For claims
17 11, 14, and 15, Appellants repeat the same argument made for claim 8. We
18 will, therefore, treat claims 11 and 15 as standing or falling with claim 8.

19 Although Appellants argue claim 14 with claim 8, claim 14 will be
20 addressed separately as it is subject to a different rejection.

21 (4) Appellants argue claims 22-27 as a group. For claims 23-27,
22 Appellants repeat the same argument made for claim 22. We will, therefore,
23 treat claims 24-27 as standing or falling with claim 22.

1 Although Appellants argue claim 23 with claim 22, claim 23 will be
2addressed separately as it is subject to a different rejection.

3 (5) Appellants argue claims 28 and 35 as a group. For claim 35,
4Appellants repeat the same argument made for claim 28. We will, therefore,
5treat claims 35 as standing or falling with claim 28.

6 (6) Appellants argue claims 29-34 as a group. For claims 30-34,
7Appellants repeat the same argument made for claim 29. We will, therefore,
8treat claims 30-34 as standing or falling with claim 29.

9 See 37 C.F.R. § 41.37(c)(1)(vii). See also *In re Young*, 927 F.2d 588,
10590 (Fed. Cir. 1991).

11

12 *The Board's Claim Construction*

13 "Our analysis begins with construing the claim limitations at issue."
14*Ex Parte Filatov*, No. 2006-1160, 2007 WL 1317144, at *2 (BPAI 2007).

15 Claims are given their broadest reasonable construction "in light of
16the specification as it would be interpreted by one of ordinary skill in the
17art." *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir.
182004).

19 To determine whether Levine anticipates claims 1-8, 11, 15-22, 24-27,
2029-34, and 36-37, we must first determine the scope of the claims. Our
21reviewing court stated in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed.
22Cir. 2005), cert. denied, sub nom. *AWH Corp. v Phillips*, 126 S. Ct. 1332
23(2006):

24 The claims, of course, do not stand alone. Rather, they

1 are part of “a fully integrated written instrument,” *Markman*,
2 52 F.3d at 978, consisting principally of a specification that
3 concludes with the claims. For that reason, claims “must be
4 read in view of the specification, of which they are a part.” *Id.*
5 at 979. As we stated in *Vitronics*, the specification “is always
6 highly relevant to the claim construction analysis. Usually, it is
7 dispositive; it is the single best guide to the meaning of a
8 disputed term.” 90 F.3d at 1582.

9 Here, independent claims 1, 7, 8, 16, 22, 28, 29, and 35 recite in
10pertinent part the following limitations: “interface,” “production options,”
11and “user accessible controls.” Similarly, claims 7, 22, and 28 recite in
12pertinent part the following limitation: “production logic.”

13 Upon our review of Appellants’ claims in light of Appellants’
14Specification, we conclude the following:

15 Appellants’ Specification specifically states that a “user interface” is
16“[t]he junction between a user and a computer program providing commands
17or menus through which a user communicates with a program. . . . Where
18the server is a web server, the user interface is a web page.” (Specification,
19para. [0018].) Thus, Appellants have defined “interface” broadly to include
20any junction by which a user can communication with a program, including
21a web page.

22 In addition, Appellants’ Specification states that regarding
23“production options,” “[t]hese options can include, for example, the number
24of copies, print resolution, specific paper source and output bins”
25(Specification para. [0002]) and that “options can include duplexing,
26landscape or portrait orientation, and finishes such as stapling or sorting”

1(Specification para. [0021]). Thus, Appellants have not limited the
2definition of “production options” to any particular action but instead have
3included any option directly related to the production of the target document.

4 Further, regarding “user accessible controls,” Appellants’
5Specification states that:

6 The web page when displayed by the client device presents a
7 user with controls for selecting options, issuing commands, and
8 entering text. The controls displayed can take many forms.
9 They may include push-buttons, radio buttons, text boxes, scroll
10 bars, or pull-down menus accessible using a keyboard and/or a
11 pointing device such as a mouse connected to a client device.

12(Appellants’ Specification para. [0018].) Thus, Appellants’ “user accessible
13controls” include any input from the client.

14 Finally, regarding “production logic,” Appellants’ Specification states
15that:

16 The logic can include a device driver as well as data used to
17 generate a user interface for selecting production options. Such
18 data may include instructions for displaying particular controls;
19 ranges of acceptable values for a particular control setting; a
20 default value for a control setting; and any other information
21 relating to the production of an electronic document.

22(Appellants’ Specification par. [0031].) Thus, Appellants’ “production
23logic” includes any driver or data relating to the production of a document.

24 “Having construed the claim limitations at issue, we now compare the
25claims to the prior art to determine if the prior art anticipates those claims.”

26*In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

27

The Anticipation Rejection

2 We first consider the Examiner's rejection of claims 1-8, 11, 15-22,
324-27, 29-34, and 36-37 under 35 U.S.C. § 102(b) as being anticipated by
4Levine.

Group (I)

6 Appellants contend "[t]he communication interface (208) described
7by Levine, column 11, lines 5-20 is a programmatic interface and is NOT an
8'interface having user accessible controls for selecting production options
9for a target document' as recited by Claim 1." (Br. 8.) Appellants further
10contend that "Levine's communication interface (208) is never exposed to a
11client." (Br. 8.) Appellants also contend that "Levine however does NOT
12teach or suggest providing a web page 'for a selected one of the production
13devices to a client upon receipt from the client of a production request
14for the target document' as recited in Claim 1." (Br. 9.)

15 The Examiner indicates that representative claim 1 is met by the
16disclosure of Levine -- a reference that incorporates the disclosure of Kovnat
17by reference.² Specifically, the Examiner indicates that Levine seeks to
18ascertain the settings of the target document processing device, thus Levine
19discloses 'providing an interface upon receiving the production request for
20a target document' and Kovnat discloses providing a dialog for enabling a
21user to select values using a user interface. (Answer 20-21.) We agree.

48² Levine incorporates the disclosure of Kovnat's Application No. 08/489,350
49which is now Patent No. 5,974,234. See Levine, col. 12, ll. 1-3.

1 Leaving aside for the moment the incorporated Kovnat disclosure, we
2 find that Levine amply discloses all limitations of representative claim 1.
3 For example, Levine discloses a printing system whereby clients
4 communicate with a plurality of printers by way of a print server having
5 many layers (FF 1-2). In Levine, the client requests a web page (e.g.,
6 “interface”) for a printing device, and the appropriate web page is returned
7 to the client with the appropriate data contained therein (FF 3-4).
8 Furthermore, Levine discloses situations whereby the client sends data and
9 issues commands (FF 5-6).

10 Thus, Levine discloses hosting an interface (e.g., web page) for one or
11 more production device, each interface having user accessible controls (e.g.,
12 job management commands issued by user) for selecting production options,
13 providing the interface to a client upon receipt from the client of a
14 production request (e.g., by enabling a user to issue commands to jobs the
15 interface knows about in the Window NT queue (i.e., suggests production
16 request already made)), and managing the production of the target document
17 for the selected production device using production options selected through
18 the interface.

19 As indicated previously, Levine incorporates the disclosure of Kovnat
20 by reference (Levine, col. 12, ll. 1-3). It is well settled that “material not
21 explicitly contained in [a] single, prior art document may still be considered
22 for purposes of anticipation if that material is incorporated by reference into
23 the document.” That is, “material incorporated by reference is effectively
24 part of the host document as if it were explicitly contained therein.”

1*Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1382 n.3 (Fed. Cir.
22007) (internal citations and quotation marks omitted).

3 Kovnat discloses, in pertinent part, “after the composite job ticket has
4been programmed, . . . a user is provided with an opportunity to modify the
5programmed composite job ticket in various ways.” (Kovnat, col. 13, ll. 37-
640). Thus, it is our view that Kovnat also discloses providing an interface to
7a client upon receipt from the client of a production request.

8 For at least the above noted reasons, we shall sustain the Examiner’s
9rejection of representative claim 1 and claims 2-7, 16-21, 36, and 37 which
10fall with claim 1.

11 *Group (2)*

12 Regarding representative claim 7, Appellants contend that “[t]he
13passages cited by the Examiner mention nothing of the use of production
14logic let alone the use of production logic to generate an interface that has
15user accessible controls.” (Br. 11-12.)

16 As noted *supra*, “production logic” includes any driver or data/
17instructions relating to the production of a document. While claim 7
18requires the use of production logic for each detected device, there is no
19requirement in claim 7 that the production logic be used to generate an
20interface that has user accessible controls. All that is required is that
21production logic be used.

22 Levine discloses checking for the addition of a new device and
23performing an Add Function call if appropriate (FF 8). Therefore, Levine
24discloses using production logic for a detected device.

1 For at least the above noted reasons, we shall sustain the Examiner's
2rejection of representative claim 7.

3 *Group (3)*

4 Regarding representative claim 8, Appellants contend, *inter alia*, that
5“Levine's user interface (134) is a physical user interface provided on a
6printing device (12) and cannot be returned to a client” (Br. 13). Appellants
7also contend that “Levine mentions nothing of returning an interface that
8includes user accessible controls for identifying a target document” (Br. 14).

9 Levine discloses a subsystem that validates user requests, queues
10requests, spools document data, schedules the job for the device, and collects
11and maintains status information (FF 7). Levine further discloses that the
12job management commands enable a user to issue commands to jobs the
13interface knows about (FF 6). It goes to follow that if the interface knows
14about the jobs, the interface must be able to inherently identify a target
15document. As such, as noted *supra*, it is our view that Levine discloses
16returning an interface that includes user accessible controls. Because Levine
17further discloses the concept of the interface knowing about jobs, it is our
18view that known jobs require that the target document be identified.

19 For at least the above noted reasons, we shall sustain the Examiner's
20rejection of representative claim 8 and claims 11 and 15 which fall with
21claim 8.

22 With respect to claim 14, Appellants repeat or rely on the same
23argument made with respect to claim 8. That argument is equally

1unpersuasive with respect to claim 14. Therefore, we sustain the Examiner's
2rejection of claim 14.

3 *Group (4)*

4 Regarding claim 22, Appellants contend that "Levine fails to teach an
5interface generator that is operable to: 1. access production logic . . . 2.
6following receipt of a production request . . . 3. having user accessible
7controls" (Br. 15.)

8 The Examiner contends that Levine discloses "a database containing
9production logic (Column 10 Lines 45-65) for one or more production
10devices, the production logic for each production device including data for
11generating a user interface having particular controls for selecting
12production options" and (Answer 10). We agree.

13 Levine discloses a database 204 that stores all relevant information
14that the proxy server has acquired from the devices 200 (production
15devices). The stored information includes driver information and strings and
16bitmaps to be displayed at the client (FF 9). As such, Levine discloses a
17database containing production logic whereby the production logic includes
18data for the generated web page that is displayed at the client.

19 For at least the above noted reasons, we shall sustain the Examiner's
20rejection of representative claim 22 and claims 24-27 which fall with claim
2122.

22 With respect to claim 23, Appellants repeat or rely on the same
23argument made with respect to claim 22. That argument is equally

1unpersuasive with respect to claim 23. Therefore, we sustain the Examiner's
2rejection of claim 23.

3 *Group (5)*

4 Regarding claim 29, Appellants contend that "Levine simply fails to
5teach a proxy service that is operable . . . to return to a client an interface for
6selecting production options" (Br. 16.)

7 The Examiner contends that Levine discloses "a proxy service in
8electronic communication with the client and the production device, the
9proxy service operable to return, in response to receiving a production
10request, (Column 4 Lines 55-65) to the client an interface for selecting
11production options for the selected production device" (Answer 11-12.)
12We agree.

13 Levine discloses that "in a typical proxy server an application layer
14communications with a connectivity layer which permits the operation
15requests to be transferred between the clients and the document processing
16devices" (FF 10). As such, it is our view that Levine discloses using a proxy
17server in communication with a client and a production device that returns
18an interface.

19 For at least the above noted reasons, we shall sustain the Examiner's
20rejection of representative claim 29 and claims 30-34 which fall with claim
2129.

22 *Group (6)*

Regarding claim 28, Appellants contend that “Levine and Goodman fail to [sic] an interface generator that is operable in the manner recited in claim 28.” (Br. 17.)

4 The Examiner contends that Levine discloses “an interface generator
5 operable to access the production logic for a production device in the
6 database and serve an interface for the production device, (Levine – Column
7 14 Lines 25-35, Column 15 Lines 45-65) . . .” (Answer 18). We agree.

8 In addition, as noted *supra*, Levine discloses production logic stored
9in databases, a proxy server in communication with both the client and the
10production device, and a user accessible interface (FF 9-11). In other words,
11it is our view that Levine discloses an interface generator (commands/calls)
12that is operable to access the production logic (driver) for a production
13device.

14 For at least the above noted reasons, we shall sustain the Examiner's
15 rejection of representative claim 28 and claim 35 which fall with claim 28.
16

17 VII. CONCLUSIONS

18 We conclude that Appellants have not shown that the Examiner erred
19 in rejecting claims 1-8, 11, and 14-37.

20 Thus, claims 1-8, 11, and 14-37 are not patentable.

21 VIII. DECISION

22 In view of the foregoing discussion, we affirm the Examiner's
23 rejection of claims 1-8, 11, and 14-37.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

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5 AFFIRMED

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